



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,686	07/13/2001	Hiroyo Masuda	FUJY 18.847	5599

7590 11/24/2006  
KATTEN MUCHIN ZAVIS ROSENMAN  
575 MADISON AVENUE  
NEW YORK,, NY 10022-2585

EXAMINER

FISCHETTI, JOSEPH A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/904,686

Applicant(s)

MASUDA ET AL.

Examiner

Joseph A. Fischetti

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/14/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***112 Second Paragraph Rejection***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 still cannot be understood because it is stated that "the obtained accounting quantity for each accounting method for the portion of the communication device already received...". The problem continues with this recitation in that it combines steps which must be otherwise set out individually and/or positively recited in order to have the effect which applicant seeks as evidenced by his remarks.

The recitation of applying a plurality of accounting methods has not been positively recited. Applicant needs to recite that a plurality of accounting methods is provided and the communication service applies each accounting method at the start of receiving each transmission in order to have the effect of "obtaining an accounting quantity for each accounting method ... already received,..."

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 3627

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,7 insofar as can be understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillis in view of Ehlers et al. and Theil.

Hillis discloses a method of displaying an accounting state for a communication service by a terminal device, comprising steps of receiving a communication service (block 40 user enters number), to which a plurality of accounting methods can be applied (account method for fixed location vs. accounting method for conference call vs. accounting method for ISU to ISU, rates are variable and hence are accounting based results which differ mutually, see cols. 6,7,8), from a network and providing the communication service for a subscriber; and displaying accounting quantities corresponding to each of said plurality of accounting methods in the process of utilizing the communication service (col. 6 lines 50 et seq. since the displayed rate result of an other accounting practice is shown in the process of its use without deference to any other method, the claim meets this limitation).

But, Hillis fails to disclose calculating accounting quantities during the process of utilizing the device based on the plurality of accounting methods for the communication service part which has been already received.

However, Ehlers et al. disclose (cols.32 lines 66,67; col. 33, lines 1-14) during the use of a resource, calculating costs using rate tables from a plurality of suppliers, each such evaluation is read as an "accounting quantity" for each supplier. It would be obvious to use this evaluation method in Ehlers to modify the method in Hillis to include evaluating the values of transmission cost for each of the accounting options presented

in Hillis, the motivation being the ability to see all data before deciding on one particular result.

In addition, Thiel does disclose different accounting methods to be displayed to the user for his/her selection (col. 10 lines 39 et seq). It would be obvious to modify the device in Hillis to include the display feature of Ehlers et al. which on-going tracks the rates of various carriers and to have each rate calculated with a different accounting method displayable to the user as taught by Theil the motivation being the ability to see bottom line pricing at the time of usage and to make a change at that point in time.

Re claim 3: the specified accounting quantity is read as the selection in Ehlers et al. between manual cost entry or manual cost entry, the motivation is again herein repeated.

Re claim 7: Hillis disclose notifying the network of pieces of information when he discloses accepting the call at col. 6, line 27, the motivation is again herein repeated.

Claims 1,2,4,5,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillis in view of Ehlers et al. and Theil as applied to claims 1,3,7 above, and further in view of Kikuchi et al.

Hillis in view of Ehlers et al. and Theil. disclose the invention substantially as claimed except they fail to disclose the specifics of claims 2,4,5,6.

RE claim 2: Kikuchi et al. disclose obtaining a piece of information on an accounting degree (see unit fee per unit time information 121) corresponding to each of said plurality of accounting methods from said network when the communication service


Art Unit: 3627

starts being utilized; and measuring, in the process of utilizing the communication service, an quantity of an accounting element corresponding to an accounting method, (speech fee process 208) calculating and displaying said accounting quantity (display 212 displays the fee from the calculation made by timer 206). It would be obvious to modify the above combination to include in Hillis the information/display feature of Kikuci et al. the motivation being the more efficient procurement of information costs which ultimately results in the lowest fees to be paid by the user.

RE claim 4 it is deemed a mere repetition of steps to calculate and display the fee for various other rates stored in the unit fee database and since these fees while at some point appear on the display 150, they are deemed to have been shown "together".

Re claim 5 and 6, the use of an alarm to sound when a value is exceeded is deemed to be an old and notorious expedient in the art. The official notice is made final.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (703) 305-0731.

  
JOSEPH A. FISCHETTI  
PRIMARY EXAMINER  
Joseph A. Fischetti  
Primary Examiner  
Art Unit 3627